APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,622	06/16/2000	Geoffrey W. Simons	INFS115627	1037

			EXAMINER
7590	01/20/2004		HUYNH, CONG LAC T

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ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)	
		09/595,622	SIMONS, GEOFFREY W.	
Office Action Summary		Examiner	Art Unit	
		Cong-Lac Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2000*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   This action is responsive to communications: the application filed on 6/16/00, and

the IDS filed on 5/15/01, priority filed 6/16/99.

2.   Claims 1-35 are pending in the case. Claims 1, 11, 19, 26, 30 and 34 are

independent claims.

Claim Objections

3.   Claim 29 is objected to because of the following informalities: the word "served"

within "the computer system as recited in claim 26 further comprising a document

served, in communication with the document browser and providing the electronic form

having one or more fields" is a typographical error since such a document can not be a

component of the computer system.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.   Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Regarding claim 12, it is unclear why the deselection of the user profile has to be

carried out for the completing of the fields of the electronic form within "receiving a user

selection indicative of the user device deselecting the user profile in an area of the

display represented by the first application, *wherein the completing of the fields of the*

electronic form does not occur until the receipt of the deselection of the user profile."

As explained in the specification, the data in the user profile is used to fill in the fields of

the electronic form. That means the user profile must be selected, not deselected.

Please explain.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Markus

et al. (US Pat No. 6,490,601 B1, 12/3/02, filed 1/15/99).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome

either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the

invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding independent claim 1, Markus discloses:

- obtaining an electronic form having one or more fields to be completed (col 5, lines 1-12, 29-35: "a form mapping containing a set of associations between *fields in the electronic form ...*", "...enabling automatic insertion of user information into *an electronic form having multiple fields ...*")

- obtaining a user profile containing user data corresponding to the one or more fields of the electronic form (col 5, lines 32-41, 45-55: ".. a memory area storing multiple raw data profiles where each raw data profile corresponds to a registered user ...", "the raw data profile includes several standard field names, each standard field name having a corresponding data string and a use-preference data item determined by a registered user...")

- completing at least one of the fields of the electronic form with the user data upon the transfer of the user profile to the electronic form (figure 4B, #440: "Browser transmits *filled out electronic form document*" inherently shows that filling of user profile data to the electronic form is complete before transmitting)

Regarding claim 2, which is dependent on claim 1, Markus discloses that obtaining a user profile includes:

- transmitting a user identification and a signature of the electronic form to a fill server (col 8, lines 1-14: "User 302 informs privacy bank server 308 of the *identity of the user and of which Web site and which form on that Web site (if*

more than one) the user wishes to have filled in. *This information is transmitted to privacy bank server ...*")

- obtaining the user profile from the fill server, wherein the user profile corresponds to the user identification and the electronic form signature (col 8, lines 40-64: the raw data profile storage area 328, one of the components of the privacy bank server which enables to fill in the electronic form on a remote user computer, includes the data profile for each registered user)

Regarding claim 3, which is dependent on claim 2, Markus discloses that the user identification includes a user ID and a user password (col 8, lines 40-64: "a registered user has an unique account that can be used as an identifier and a password...").

Regarding claim 4, which is dependent on claim 2, Markus discloses that the electronic form signature includes a text string having a uniform resource locator of the electronic form (col 7, lines 40-62: "a purchasing form, typically an HTML document, is returned and downloaded into and displayed in a browser window..."; the fact that the purchasing form is a HTML document inherently shows that the HTML document, which includes the electronic form, has an uniform resource locator; col 11, lines 43-49: the user identifier and the URL for identifying the document containing the form; col 13, lines 38-48: the identifier of the electronic form contains the identifier of the merchant's Web site in the form of a URL).

Regarding claim 5, which is dependent on claim 1, Markus discloses that the electronic

form signature includes a descriptor of the one or more fields of the electronic form (col

17, lines 8-15: the name strings or field names or guides to entering data in an

electronic form; col 9, lines 1-13: the field names are the descriptors of the fields in an

electronic form).

Regarding claim 6, which is dependent on claim 4, Markus discloses that the electronic

form signature includes a descriptor of one or more actions requested by the electronic

form (col 11, lines 39-49: the fact that the URL which is used by the privacy bank server

to determine how the electronic form document should be filled suggests that said URL,

which is the electronic form signature, contains a descriptor of action requested by the

electronic form).

Regarding claim 7, which is dependent on claim 1, Markus discloses that the user

profile is represented by a graphical icon on a display screen and wherein the user

profile is transferred to the electronic form manipulating the icon within the display

screen (col 11, lines 15-22: ".. by *clicking on the autofill button*, the user allows the

browser to execute the shippable code or *profile stored thereon...*").

Regarding claim 8, which is dependent on claim 1, Markus discloses that the user

profile includes shippable code embodying the user data corresponding to the fields of

the electronic form, and wherein completing at least one of the fields of the electronic

form includes executing the shippable code to complete at least one of the fields of the

electronic form (col 5, lines 29-44).

Claims 9 and 10 are for a computer-readable medium and a computer system of any of

method claims 1-8, and are rejected under the same rationale.

Regarding independent 11, Markus discloses:

- displaying a first application indicative of an electronic form having one or more

   fields (figure 3A, #316 and col 7, lines 41-62: form 316 includes fields for filling

   data; figure 4A, #402 Electronic form document is loaded into browser)

- displaying a second application indicative of a user profile containing data

   corresponding to one or more fields of the electronic form (figure 4A, #408-418:

   the fact that the browser for displaying the electronic form connects with the

   privacy bank and gets cookie and user data corresponding to cookie from the

   privacy bank server inherently shows that the user profile data of the privacy

   bank server is displayed in a different window)

- receiving a user selection indicative of the user device selecting the user profile

   (col 7, lines 59-62: the fact that user 302 can *"click"* on a privacy bank *icon or*

   button in form 316 where the privacy bank contains the user profile shows an

   indication of user device selecting the user profile)

- receiving a user selection indicative of the user device transferring the user

   profile from the second application to the first application (figure 4A, #424: the

fact that "User selects privacy bank autofill icon/button" indicates transferring

user profile to the electronic form document via selecting the autofill button)

- completing at least one of the one or more of the fields of the electronic form (col

    7, lines 41-62 and figure 3A, #316: "the process of automatic electronic form

    completion begins with a user downloading the form from a Web site ...user 302

    can "click" on a privacy bank icon or button in form 316 and have the form

    automatically filled in"; figure 4B, #440: "Brower transmits filled out electronic

    form document" indicates that the form filling is complete before transmitting)

Regarding claim 12, which is dependent on claim 11, Markus discloses receiving a user

selection indicative of the user device deselecting the user profile in an area of the

display represented by the first application, wherein the completing of the fields of the

electronic form does not occur until the receipt of the deselection of the user profile (col

15, lines 41-50: if one of the fields in the form from the merchant does not meet the

condition of a user, that means the data in *the user profile is rejected or deselected by*

the user for filling, none of the fields in the form are filled in and the process is complete;

col 16, lines 8-25).

Regarding claim 13, which is dependent on claim 11, Markus discloses the user profile

is a graphical icon displayed on a display screen (col 11, lines 15-30: clicking on the

autofill button, the user allows executing the profile stored thereon).

Regarding claim 14, which is dependent on claim 11, Markus discloses that the user

profile includes shippable code embodying the user data corresponding to the one or

more fields and wherein completing the one or more fields of the electronic form

includes executing the shippable code to complete at least one of the fields of the

electronic form (col 11, lines 15-25: by clicking on the autofill button, the user allows the

browser to execute the shippable code stored thereon; col 11, lines 43-62: the

shippable code contains user data that allows the form document to be filled out

automatically).

Regarding claims 15 and 16, which are dependent on claims 11 and 15 respectively,

Markus discloses:

- the first application is displayed as a rectangular window in the graphical user

  interface (figure 3A, #304 and figure 4A, #402: browser for loading the electronic

  form having multiple fields in a rectangular window)

- the second application is displayed as a rectangular window in the graphical user

  interface (figure 4A, #408, 410, 416, 418: the fact that the browser for displaying

  the electronic form connects with the privacy bank and gets cookie and user data

  corresponding to cookie from the privacy bank server inherently shows that the

  user profile data of the privacy bank server is displayed in a different window,

  which is conventionally a rectangular window)

Claims 17 and 18 are for a computer-readable medium and a computer system of any

of method claims 11-16, and are rejected under the same rationale.

Regarding independent claim 19, Markus discloses:

- obtaining a user identification corresponding to a user profile (col 8, lines 50-64:

   the raw data profile storage contains set of data relating to registered users of the

   privacy bank service where a registered user has a unique account number as

   an identifier and a password for identification)

- obtaining a form signature of an electronic form having one or more fields (col 11,

   lines 43-49: the electronic form document has an identifier such as a URL of the

   web site containing the form)

- generating a fill bundle corresponding to a merger of data within the user profile

   and a form map corresponding to the form signature, wherein the fill bundle is

   embodied in a graphical representation (figure 6, #608 Server merges mapping

   table with user's raw data profile, #610 Server converts merger into shippable

   code and col 13, line 49 to col 14, line 29: generating a shippable code in the

   form of a JavaScript program where the shippable code, converted from the

   merger of legacy bank name and raw data value associated with the user, is

   used to fill in the form on the user browser; the shippable code bundles data for

   filing the electronic form, and is corresponding to a fill bundle)

Regarding claim 20, which is dependent on claim 19, Markus discloses obtaining the

user profile corresponding to the user identification from a database having one or more

user profiles organized according to a user identification (figures 3A-B and col 8, lines

40-64: raw data profile contains sets of data relating to registered user of the privacy

bank service where a registered user has a unique account number as a user

identification).

Regarding claim 21, which is dependent on claim 19, Markus discloses the form map

corresponding to the form signature from a database having one or more maps

organized according to a form signature (figure 7 and col 14, lines 30-52).

Regarding claim 22, which is dependent on claim 19, Markus discloses that if the form

map database does not have a form map corresponding to the form signature,

generating a form map based upon the form signature (col 13, line 49 to col 14, line 4:

the privacy bank server uses the URL or other identifier for the specific form to be filled

out to retrieve a mapping of each field name in the electronic form to privacy bank

standardized names; the merchant submits one or more forms to privacy bank which

then examines each field name in the forms and matches it with a privacy bank field

name; the fact that if the legacy name does not match the privacy bank field names,

then the privacy bank user raw data *can be updated to* include the legacy name based

upon the identifier of the form <u>indicates that</u> when the privacy bank server whose form

map database does not have the form map of the newly submitted form from the

merchant, the privacy bank raw data *is updated to include the newly created form map*

of the new form based upon the corresponding URL or the form signature).

Regarding claim 23, which is dependent on claim 19, Markus discloses that the fill

bundle includes shippable code containing commands for completing one or more

corresponding fields of the electronic form (col 14, lines 5-29: "normally browser

programs have a JavaScript component that is manipulable by JavaScript commands.

These JavaScript commands in the shippable code are used to fill in the electronic form

on the browser, a technique well known in the field of Internet and Java

programming..").

Claims 24 and 25 are for a computer-readable medium and a computer system of any

of claims 19-23, and are rejected under the same rationale.

Regarding independent claim 26, Markus discloses a computer system for completing

electronic form comprising:

- a document browser operable to access and manipulate an electronic form

    having one or more fields (figure 3A, #316, figure 4A, #402 Electronic form

    document is loaded into browser, #404 Browser parses electronic form document

    content to identify external links)

- a fill server in communication with the document browser and providing a

    graphical representation of executable code embodying user profile data for

completing at least one of the fields of the electronic form (figure 3A, #3 , #304

Document browser, # User profile data; figure 4A, #422 Browser retrieves

shippable code from privacy bank server, #424 User selects privacy bank autofill

icon/button; *the privacy bank server is where to create the fill bundle* which is the

shippable code for filling data in the form from a remote user computer, is

considered as a fill server; the privacy bank server in communication with the

document browser in a graphical representation that has an autofill button for

executing the filling process)

Regarding claim 27, which is dependent on claim 26, Markus discloses that the system

further comprises a user information server in communication with the fill server and

providing user profile data to the fill server (col 7, line 63 to col 8, line 39: the fact that

the Markus system has the capability of providing user profile data and creating fill

bundle embodied in shippable code for filling data in the user profile to electronic forms

in a remote computer inherently shows that the Markus system includes a user

information server in communication with the fill server).

Regarding claim 28, which is dependent on claim 26, Markus discloses a form map

server in communication with the fill server and providing form maps corresponding to

one or more fields of an electronic form, wherein the graphical representation includes a

merger of a form map and user profile data (figure 6 and col 13, line 49 to col 14, line

29: the merger of mapping table, including form map, with user's raw data profile in a

user's browser shows that the graphical representation of the browser window includes the merger; the mapping table retrieved from the privacy bank database connected to the user's browser where to display the form and the web site that contains the form and to fill in the form inherently shows that the privacy bank database which stores the table of form mapping is considered as a form map server, and the privacy bank server is where to create the fill bundle embodied in shippable code is considered as the fill server).

Regarding claim 29, which is dependent on claim 19, Markus discloses a document served, in communication with the document browser and providing the electronic form having one or more fields (figure 6, #602 Privacy bank server retrieves user cookie and electronic form document identifier from browser, it was obvious an electronic form has one or more fields).

Claims 30-33 are for a computer readable medium of method claims 19-23, and are rejected under the same rationale.

Claims 34-35 are for a computer readable medium of method claim 14, and are rejected under the same rationale.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dozier et al. (US Pat No. 5,870,552, 2/9/99, filed 3/28/95).

Gupta et al. (US Pat No. 6,199,079 B1, 3/6/01, filed 3/20/98, priority 3/9/98).

Mohan et al. (US Pat No. 6,505,230 B1, 1/7/03, filed 5/14/99).

Light et al. (US Pat No. 6,192,380 B1, 2/20/01, filed 3/31/98).

Kennedy et al. (US Pat No. 6,651,217 B1, 11/18/03, filed 9/1/99).

Rawat et al. (US Pat No. 6,662,340 B2, 12/9/03, filed 5/30/02, priority 4/28/00).

Elias et al. (US Pat No. 5,844,971, 12/1/98, filed 12/18/95).

Atlas et al. (US Pat No. 6,208,339 B1, 3/27/01, filed 6/19/98).

Mukherjee, Automating Forms Publishing with the Intelligent Filling Manager, IEEE

1999, pages 308-313.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-

0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number

for the organization where this application or proceeding is assigned is 703-746-7239.

        Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

9000.

clh
1/8/04

STEPHEN S. HONG
PRIMARY EXAMINER